



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,551	08/29/2000	Jonathan B. Orlick	ST/044	8362

7590

08/25/2004

Alexander Shvarts
Fish & Neave
1251 Avenue of the Americas
New York, NY 10020-1105

EXAMINER

MA, JOHNNY

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 08/25/2004

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/555,551

Applicant(s)

ORLICK, JONATHAN B.

Examiner

Johnny Ma

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12,13,15-19,21 and 24-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-10,12,13,15-19,21 and 24-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 17, 20.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 3-10, 12-13, 15-19, and 21 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3-7, 12-13, 15-19, 21, 24-25, 30-32, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Knudson et al. (US 2002/0120933 A1).

As to claim 1, note the Knudson et al. reference that discloses a program guide system with flip and browse advertisements. The claimed “a receiver for recovering a television signal being currently broadcast” is met by “[c]ommunications paths 46 preferably have sufficient bandwidth to allow television distribution facility 38 to distribute scheduled television programming, pay programming, advertising and other promotional videos, and other video information to set-top boxes...” (Knudson et al. [0037]) wherein set top box recovers broadcasted television signals (Knudson et al. [0047]). The claimed “a display monitor for displaying the recovered television signal” is met by “[v]ideo for the current channel to which the user’s set-top box is tuned (i.e., the current channel that the user is viewing) is displayed on the user’s television screen 68” (Knudson et al. [0047]). The claimed “means for displaying on a

Art Unit: 2614

substantially full portion of the monitor a television picture from the recovered television signal” is met by the disclosed flip display arrangement with advertisements wherein “[v]ideo for the current channel to which the user (i.e., set-top box 48 of FIG. 1) is tuned is displayed on screen 78” (Knudson et al. [0050]). The claimed “means for selecting an advertising message related to the displayed television picture from a plurality of advertising messages related to the displayed television picture” is met by displaying advertisements to viewers in program guide browse and flip displays (Knudson et al. [0050]), the advertising being related information may be presented to the user based on the user’s interests (Knudson et al. [0045]), wherein selecting from a plurality of advertising messages is inherent to the display of advertisements to users of various interests. The claimed “means for displaying a pop up window overlaid on the displayed television picture” is met by browse and flip program guide overlay displays (Knudson et al. [0050]) also see Figures 6 and 7. The claimed “ the pop up window including the selected advertising message” is met by “the program guide provides browse and flip displays that contain advertisements” (Knudson et al. [0050]). The claimed pop up window including “an informational message related to the displayed television picture other than program title” is met by browse display including informational messages conveying station number, station name, and program time in addition to program title, see Figure 7 (Knudson et al.). The claimed “wherein the television picture is simultaneously displayed with both the informational message and the advertising message” is met by browse display, as illustrated in Figure 7, wherein the display includes advertisement, program title, program channel/station, and program time (Knudson et al., see Figure 7).

Art Unit: 2614

As to claim 3, the claimed “wherein the informational message relates to content of the television picture from the recovered television signal” is met by “[w]hen browse display 80 is initially invoked by the user by pressing a cursor key 62, browse display 80 contains program listing 84 for the current channel (e.g., channel 6) and time...”, also see Figures 6 and 7 (Knudson et al. [0051]).

As to claim 4, the claimed “wherein the informational message relates to later programming on a channel of the recovered television signal” is met by “[w]hen browse display 80 is initially invoked by the user by pressing a cursor key 62, browse display 80 contains program listing 84 for the current channel (e.g., channel 6) and time...”, also see Figures 6 and 7 (Knudson et al. [0051]) wherein “...the program guide may provide a browse display 88 that allows the user to browse program listings for programs that are schedule to be aired at times other than the current time, [future programs]” (Knudson et al. [0052], also see Figure 7).

As to claim 5, the claimed “wherein the informational message relates to current programming on a channel of the recovered television signal” is met by “[w]hen browse display 80 is initially invoked by the user by pressing a cursor key 62, browse display 80 contains program listing 84 for the current channel (e.g., channel 6) and time...”, also see Figures 6 and 7 (Knudson et al. [0051]).

As to claim 6, the claimed “additionally comprising means for displaying a composite of an EPG and an advertising message overlaid on the displayed television picture” is met by the display of browse and flip program guide displays overlaid on top of a screen, including an advertising message (Knudson et al. [0050], also see Figures 6 and 7).

As to claim 7, please see rejection of claim 6.

Art Unit: 2614

As to claim 12, the claimed “in which the selected advertising message is about a product or service” is met by advertisements for various products and services (Knudson et al. [0030, 0050]).

As to claim 13, note the Knudson et al. reference that discloses a program guide system with flip and browse advertisements. The claimed “recovering a television signal being currently broadcast” is met by “[c]ommunications paths 46 preferably have sufficient bandwidth to allow television distribution facility 38 to distribute scheduled television programming, pay programming, advertising and other promotional videos, and other video information to set-top boxes...” (Knudson et al. [0037]) wherein set top box recovers broadcasted television signals (Knudson et al. [0047]). The claimed “displaying on a substantially full portion of a monitor a television picture from the recovered television signal” is met by the disclosed flip display arrangement with advertisements wherein “[v]ideo for the current channel to which the user (i.e., set-top box 48 of FIG. 1) is tuned is displayed on screen 78” (Knudson et al. [0050]). The claimed “selecting an advertising message related to the displayed television picture from a plurality of advertising messages related to the displayed television picture” is met by displaying advertisements to viewers in program guide browse and flip displays (Knudson et al. [0050]), the advertising being related information may be presented to the user based on the user’s interests (Knudson et al. [0045]), wherein selecting from a plurality of advertising messages is inherent to the display of advertisements to users of various interests. The claimed “displaying a pop up window overlaid on the displayed television picture” is met by browse and flip program guide overlay displays (Knudson et al. [0050]) also see Figures 6 and 7. The claimed “ the pop up window including the selected advertising message” is met by “the program guide provides

Art Unit: 2614

browse and flip displays that contain advertisements” (Knudson et al. [0050]). The claimed pop up window including “an informational message related to the displayed television picture other than program title” is met by browse display including informational messages conveying station number, station name, and program time in addition to program title, see Figure 7 (Knudson et al.). The claimed “wherein the television picture is simultaneously displayed with both the informational message and the advertising message” is met by browse display, as illustrated in Figure 7, wherein the display includes advertisement, program title, program channel/station, and program time (Knudson et al., see Figure 7).

As to claim 15, the claimed “wherein the informational message relates to content of the television picture from the recovered television signal” is met by “[w]hen browse display 80 is initially invoked by the user by pressing a cursor key 62, browse display 80 contains program listing 84 for the current channel (e.g., channel 6) and time...”, also see Figures 6 and 7 (Knudson et al. [0051]).

As to claim 16, the claimed “wherein the informational message relates to later programming on a channel of the recovered television signal” is met by “[w]hen browse display 80 is initially invoked by the user by pressing a cursor key 62, browse display 80 contains program listing 84 for the current channel (e.g., channel 6) and time...”, also see Figures 6 and 7 (Knudson et al. [0051]) wherein “...the program guide may provide a browse display 88 that allows the user to browse program listings for programs that are schedule to be aired at times other than the current time, [future programs]” (Knudson et al. [0052], also see Figure 7).

As to claim 17, the claimed “wherein the informational message relates to current programming on a channel of the recovered television signal” is met by “[w]hen browse display

Art Unit: 2614

80 is initially invoked by the user by pressing a cursor key 62, browse display 80 contains program listing 84 for the current channel (e.g., channel 6) and time...", also see Figures 6 and 7 (Knudson et al. [0051]).

As to claim 18, the claimed "additionally comprising displaying a composite of an EPG and an advertising message overlaid on the displayed television picture" is met by the display of browse and flip program guide displays overlaid on top of a screen, including an advertising message (Knudson et al. [0050], also see Figures 6 and 7).

As to claim 19, please see rejection of claim 18.

As to claim 21, the claimed "in which the selected advertising message is about a product or service" is met by advertisements for various products and services (Knudson et al. [0030, 0050]).

As to claim 24, please see rejection of claim 1.

As to claim 25, the claimed "wherein the selected advertising message is about an upcoming television program or event" is met by selectable advertisement may be an advertisement for a future television program (Knudson et al. [0065]).

As to claim 30, the claimed "wherein a different advertising message is selected and displayed after a predetermined time" is met by "[t]he content of advertisement 82 may be cycled (i.e., replaced periodically by another advertisement" (Knudson et al. [0050]).

As to claim 31, please see rejection of claim 13.

As to claim 32, the claimed "wherein the selected advertising message is about an upcoming television program or event" is met by selectable advertisement may be an advertisement for a future television program (Knudson et al. [0065]).

As to claim 37, the claimed “wherein a different advertising message is selected and displayed after a predetermined time” is met by “[t]he content of advertisement 82 may be cycled (i.e., replaced periodically by another advertisement” (Knudson et al. [0050]).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson et al. (US 2002/0120933 A1) in further view of Alten et al. (US 5,635,978).

As to claim 8, note the Knudson et al. reference discloses distributing non-video program guide and advertising data to set top boxes wherein storage of such data at set top box is inherent to their utilization (Knudson et al. [0037]). However, the Knudson et al. reference is silent as to the storage of EPG data including background color. Now note the Alten reference that discloses the storage of bitmaps in the system for use as “mood background” viewing (Alten 11:34-38). Alten specifically discloses the use of a “nighttime view” (Alten 11:42) and (Fig. 5c) as an example. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Knudson et al. EPG display with the Alten et al. background coloring for the purpose of easing the monotony of viewing program listings.

As to claim 9, please see rejection of claim 8.

Art Unit: 2614

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson et al. (US 2002/0120933 A1) in further view of Alten et al. (US 5,635,978) and Marshall et al. (US 5,828,420).

As to claim 10, note the Knudson et al. and Alten et al. combination teaches an EPG guide including stored background color values. However, the Knudson et al. and Alten et al. combination is silent as to the use of a transparent value for the background color. Now note the Marshall et al. reference that discloses an EPG that uses a transparent value for the background of the EPG (Fig. 9). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Knudson et al. and Alten et al. combination with the Marshall et al. transparent background color for the purpose of maintaining the full screen view of the television program while viewing the program listing for the viewer's entertainment.

7. Claims 26-27 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson et al. (US 2002/0120933 A1) in further view of Schein et al. (US 2003/0208758 A1).

As to claims 26 and 27, the claimed "wherein the selected advertising message is related to a sponsor of the displayed television picture" and "wherein the selected advertising message promotes products and services of the sponsor." Note the Knudson et al. reference discloses programming related advertisements that promote a television program or channel or non-programming products and services (Knudson et al. [0050]). However, the Knudson et al. reference does not specifically disclose advertising messages relating to a television program sponsor. Now note the Schein et al. reference that discloses a method and system for displaying panel advertisements in an electronic program guide wherein advertisement messages may

Art Unit: 2614

advertise programs or products from program sponsors, etc. (Schein et al. [0081]). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Knudson et al. electronic program guide advertisements including products and services with the Schein et al. program sponsor advertisements for the purpose of providing a program sponsor with an additional benefit of increasing exposure of viewers to its' products/services and an additional means revenue.

As to claims 33 and 34, the claimed "wherein the selected advertising message is related to a sponsor of the displayed television picture" and "wherein the selected advertising message promotes products and services of the sponsor." Note the Knudson et al. reference discloses programming related advertisements that promote a television program or channel or non-programming products and services (Knudson et al. [0050]). However, the Knudson et al. reference does not specifically disclose advertising messages relating to a television program sponsor. Now note the Schein et al. reference that discloses a method and system for displaying panel advertisements in an electronic program guide wherein advertisement messages may advertise programs or products from program sponsors, etc. (Schein et al. [0081]). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Knudson et al. electronic program guide advertisements including products and services with the Schein et al. program sponsor advertisements for the purpose of providing a program sponsor with an additional benefit of increasing exposure of viewers to its' products/services and an additional means revenue.

8. Claims 28 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson et al. (US 2002/0120933 A1) in further view of Zigmond et al. US 6,698,020 B1).

Art Unit: 2614

As to claim 28, note the Knudson et al. reference discloses programming related advertisements that promote a television program or channel or non-programming products and services (Knudson et al. [0050]). However, the Knudson et al. reference does not specifically disclose an advertising message related to a subject of the displayed television picture. Now note the Zigmond et al. reference that discloses techniques for intelligent video ad insertion wherein advertisements relating to the subject matter of a particular program may be displayed to a viewer (Zigmond et al. 12:60-62). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Knudson et al. electronic program guide advertisements including products and services with the Zigmond et al. advertisements relating to program subject matter for the purpose of allowing an advertiser to request display of his/her advertisement in accordance with related program content, such as promoting a current-release motion picture during programs featuring the cast members of the motion picture (Zigmond et al. 12:62-67) thus targeting promotions to viewers to may more likely be interested in the advertiser's product or service.

As to claim 35, note the Knudson et al. reference discloses programming related advertisements that promote a television program or channel or non-programming products and services (Knudson et al. [0050]). However, the Knudson et al. reference does not specifically disclose an advertising message related to a subject of the displayed television picture. Now note the Zigmond et al. reference that discloses techniques for intelligent video ad insertion wherein advertisements relating to the subject matter of a particular program may be displayed to a viewer (Zigmond et al. 12:60-62). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the

Art Unit: 2614

Knudson et al. electronic program guide advertisements including products and services with the Zigmond et al. advertisements relating to program subject matter for the purpose of allowing an advertiser to request display of his/her advertisement in accordance with related program content, such as promoting a current-release motion picture during programs featuring the cast members of the motion picture (Zigmond et al. 12:62-67) thus targeting promotions to viewers to may more likely be interested in the advertiser's product or service.

9. Claims 29 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson et al. (US 2002/0120933 A1).

As to claim 29, the claimed "wherein a different advertising message is selected each time the pop up window is displayed." Note the Knudson et al. reference discloses "[t]he content of advertisement 82 may be cycled (i.e., replaced periodically by another advertisement" (Knudson et al. [0050]). However, the Knudson et al. reference does not specifically disclose the display of a different advertising message each time the pop up window is displayed.

Nevertheless, the examiner gives Official Notice that it is notoriously well known in the art to display different advertisements to users for the purpose of maximizing advertising revenue and to increase the likelihood that a user will view and advertised product or service of interest to the viewer and for the further purpose of providing variety to a user. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Knudson et al. display electronic program guide advertisements including products and services accordingly for the above stated advantages.

As to claim 36, the claimed "wherein a different advertising message is selected each time the pop up window is displayed." Note the Knudson et al. reference discloses "[t]he content

Art Unit: 2614

of advertisement 82 may be cycled (i.e., replaced periodically by another advertisement” (Knudson et al. [0050]). However, the Knudson et al. reference does not specifically disclose the display of a different advertising message each time the pop up window is displayed. Nevertheless, the examiner gives Official Notice that it is notoriously well known in the art to display different advertisements to users for the purpose of maximizing advertising revenue and to increase the likelihood that a user will view and advertised product or service of interest to the viewer and for the further purpose of providing variety to a user. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Knudson et al. display electronic program guide advertisements including products and services accordingly for the above stated advantages.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Yuen et al. reference (US 2003/0188311 A1) discloses a method and system for displaying advertisements between schedule listings.

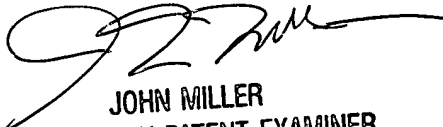
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnny Ma whose telephone number is (703) 305-8099. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703) 305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jm


JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600